

REMARKS

Applicant has carefully reviewed the Examiner's November 3, 2003 Official Action and respectfully requests reconsideration based on the above amendments and the following comments.

Claims 1-5 have been canceled and claims 6-8 added. Claims 6-8 remain in the application for consideration.

The Examiner has rejected claim 1 under 35 U.S.C. 102(b) as being anticipated by Yoshimasa, claim 2 under 35 U.S.C. 103(a) as being unpatentable over Yoshimasa in view of Blonder, claim 3 under 35 U.S.C. 103(a) as being unpatentable over Yoshimasa in view of Liautaud, claim 4 under 35 U.S.C. 103(a) as being unpatentable over Yoshimasa in view of Furano, and claim 5 under 35 U.S.C. 103(a) as being unpatentable over Yoshimasa in view of Atsushi. Applicant respectfully traverses all of these rejections especially as applied to new claims 6-8.

Applicant first notes that all the above rejections are not in accord with MPEP 706.02 - Reliance Upon Abstracts and Foreign Language Documents in Support of a Rejection.

In this regard, Applicant notes that Yoshimasa (JP3050147-U) is a foreign language document clearly falling within the instructions of the MPEP 706.02 section identified

above. As such, the following language from that section applies to the Yoshimasa reference cited.

If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection.

Not only has the Examiner not provided the translation required above, Yoshimasa does not include an English abstract. Accordingly, it is not possible for the applicant to determine the precise facts the Examiner is relying upon to support his rejection and therefore the record is not clear.

Applicant submits that the Examiner's Office Action should be withdrawn and a new first action be provided, accompanied by a translation of the Yoshimasa reference to enable applicant to determine the facts upon which the Examiner is relying to support his rejection.

In the meantime, Applicant has chosen to respond to the Examiner's rejection as best able in order to expedite prosecution. However, applicant does not believe that this response in any way justifies a final office action by the Examiner, as that would be entirely improper in view of the above cited MPEP section.

In new claims 6-8, applicant has clarified that a primary inventive feature of the claimed invention resides in the finger-mounted portion (5) provided on the rear surface of the vibrating portion of the bone conduction speaker (1). The finger-mounted portion (5) has a cap shape or a ring shape which permits the bone conduction speaker (1) to be mounted on a finger tip of the user through the finger-mounted portion.

The finger-mounted portion (5) of the bone conduction speaker (1) having the above construction is set forth in new claim 6, and is supported in the specification by a description appearing in lines 21-25 on page 3, which indicates that "the vibrating portion of the bone conduction speaker has its rear surface formed into a finger-mounted portion which assumes a cap shape or a ring shape to enable the bone conduction speaker to be mounted on a finger tip of the user."

The Examiner maintains that Yoshimasa teaches a mobile telephone unit (Fig. 1) comprising a speaker, through which a user listens for a received voice sound, and is separated from a main body of said mobile telephone unit by means of an earphone. The earphone (Fig. 2, 6A) is equipped with bone-conduction answering apparatus (paragraph 0005-0007) ".

Applicant respectfully submits that Yoshimasa, as best can be determined from the drawings, teaches only an

earphone (6), but does not teach nor suggest the finger-mounted portion (5) defined in new claim 6.

As for the earphone, Yoshimasa seems to suggest that the earphone is inserted into the user's ear for bone-conduction use. If so, it is clear that the earphone of Yoshimasa would be extremely poor in bone-conduction efficiency due to the presence of a relatively thick and flexible ear tissue between the earphone and the bone of the user, through which flexible tissue the bone of the user is separated from the earphone.

Further, if the user tries to apply the earphone to his or her forehead or like thin-tissue portion (other than the ear) in order to improve the earphone in bone-conduction efficiency, the earphone would be found to be inconvenient due to its shape. In other words, it would be difficult to the user's body for bone-conduction use.

In comparison, the finger-mounted portion (5) of the claimed invention is described in the specification on page 5, lines 10-16, as follows:

"when the user makes or answers a phone call, one or two of his/her fingers (in general, his/her first finger and thumb) is or are inserted into the finger-mounted portion (5) of the bone conduction speaker (1) to have the bone conduction speaker (1) brought into soft contact with his/her forehead, temple, cheekbone or an area between his/her eyes in order to catch a received voice sound."

In view of the above description, and with reference to Fig. 1 illustrating the finger-mounted portion (5) of the claimed invention, it is clear that the bone-conduction speaker (1) provided with such finger-mounted portion (5) of the present invention has an inventive step beyond the earphone of Yoshimasa as it facilitates the user's ability to apply the speaker to the thin-tissue head portion for bone-conduction use. Further, applicant submits that there is no teaching of the finger-mounted portion in Liautaud. Liautaud teaches only a bone conduction speaker unit that can be mounted inside the collar of a shirt (Fig. 7); thus, if a coat is worn, the speaker units can be pressed against the body of the user to permit mechanical sound transmission to the inner ear of the user through the speaker.

Fig. 7 of Liautaud shows speaker units 15, 16 in bone conduction use being too far from a hearing organ or head portion of the user 11 in comparison with the bone conduction speaker (1) of the claimed invention, in which the bone conduction speaker (1) is brought into contact with the user's head portion such as the forehead, temple, cheekbone or the area between his/her eyes, as described on page 5, lines 14-16.

Therefore, it is clear that new claim 6 has the inventive steps beyond the prior art in bone conduction

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efficiency, even when the teaching of Liautaud is provided to Yoshimasa in the prior art.

In response to the Examiner's rejection of claims 1-5 under 35 U.S.C. 112, second paragraph, Applicant has canceled claims 1-5 in favor of new claims 6-8 which have been drafted to eliminate the term to which the Examiner has objected. Applicant submits that this rejection has now been overcome.

Applicant submits that the invention is new and unobvious and not disclosed by the cited art. Accordingly, Applicant respectfully solicits the Examiner's early review and issuance of this application.

Respectfully submitted,

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